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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,171	04/30/2001	Max Jaffe	130149-1000	4933

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GARDERE WYNNE SEWELL LLP
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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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01/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/846,171

Applicant(s)

JAFJE, MAX

Examiner

JAGDISH PATEL

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/22/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9, 10, 16, 24-29, 35, 43-48, 54, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10, 16, 24-29, 35, 43-48, 54, 62 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to amendment filed 10/22/07.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/07 has been entered.

Response to Amendment

3. Claims 1-5, 9, 10, 16, 24-29, 35, 43-48, 54, 62 and 63 are pending in the present application. Claims 1, 4, 24, 28 and 43 have been amended. Claims 62 and 63 have been added.

Response to Arguments

4. Applicant's remarks/arguments have been considered in light of the amended claims and are deemed persuasive. Rejections under 35 U.S.C. § 112, second paragraph (claims 1-5, 9, 10, 16, 24-29, 35, 43-48 and 54) and rejection of claims 1-5, 9, 10, 16, 24-29, 35, 43-48 and 54 under 35 U.S.C. § 103 as being unpatentable over Linden ("Money Matters," Macword volume 10, number 6, pp. 119-125, June 1993) in view of "Tax Freedom Day" (April 12, 1993, herein "Tax Freedom") have been withdrawn.

Claim Rejections - 35 USC § 112

5. Claims 1-5, 9, 10, 16, 24-29, 35, 43-48, 54, 62 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is discussed as exemplary claim. Other independent claims also contain same deficiency.

- a. Claim 1 recites the limitation "the user's pay rate" in calculating a cost associated with each of the plurality of expenditures... There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 9, 10, 16, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The following excerpts are provided from recent ruling by the U.S. Court of Appeals for the Federal Circuit. (see *In re Stephen W. Comiskey, 2006-1286*). Emphasis added for relevance to the claims under examination>

"Second, the abstract concept may have a practical application. The Supreme Court has reviewed process patents reciting algorithms or abstract concepts in claims directed to industrial processes. In that context, the Supreme Court has held that a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. 35 U.S.C. § 101. **As the PTO notes, "[t]he Supreme Court has recognized only two instances in which such a method may qualify as a section 101**

process: when the process 'either [1] was tied to a particular apparatus or [2] operated to change materials to a 'different state or thing.'" See PTO Supp. Br. 4 (quoting Flook, 437 U.S. at 588 n.9). In Diehr, the Supreme Court confirmed that a process claim reciting an algorithm could state statutory subject matter if it: (1) is tied to a machine or (2) creates or involves a composition of matter or manufacture. .."

Claim 1 and dependent claims recite a method which fail both tests. The method is neither tied to an apparatus (e.g. a computer) nor operated to change materials to a different state or things. On this basis the claims stand rejected as recited nonstatutory subject matter under 35 USC 101.

The Court has held that the "transformation and reduction of an article to a different state or thing" is the clue to the patentability of a process claim that does not include particular machines. *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. Jul. 23, 1998).

The instant claims do not meet this standard of a statutory definition of a process claim since the claimed method does not include a machine or apparatus. (in other words, *State Street* is no applicable standard or authority for determination of statutory subject matter where no apparatus is used to perform the method).

It is suggested that claim be amended to read:

A method for"said method implemented on a computer system and comprising.."

Claim Objections

7. Claims 24 (and dependent claims) and claims 43 (and dependent claims) objected to because of the following informalities:

8. Claim 24, in the preamble should recite "A computer executable program" in place of "a computer program" because this would render the claimed invention as functional. Appropriate correction is required.

9. Claim 43 should be recited as a system or apparatus claim and not as a "computer-readable medium" because in the present form it is vague and unclear. The claimed invention is directed to a "computer-readable medium" while the body of the claim recite as if it is a processor. [It is improper to recite that a CD-ROM or a DVD comprises a processor!].

The following format is suggested.

A system for

comprising:

a processor;

a memory unit coupled to the processor, the memory unit having a computer executable program stored therein to:

....

Allowable Subject Matter

10. Claims 1-5, 9, 10, 16, 24-29, 35, 43-48, 54, 62 and 63 are allowable over the prior art of record subject to correction of the defects identified in above sections.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on **800AM-630PM Mon-Tue and Thu.**

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

1/7/08